

REMARKS

The above-referenced patent application has been reviewed in light of the Office Action, dated February 21, 2007. Claims 1 and 3-12 are pending in the present application. No claims are currently amended. Claims 1 and 3-12 stand rejected under 35 USC § 103 as being unpatentable over US Patent Publication No. 2005/0058149 of Howe (hereinafter Howe) in view of US Patent No. 6, 763,010 of Pirainen et al. (hereinafter Piirainen). In addition claim 3 stands objected to under MPEP 2106. Reconsideration of the above-referenced patent application in view of the foregoing amendments and the following remarks is respectfully requested.

With regard to the substance of the Examiner's rejections, Assignee again respectfully asserts that the Examiner has failed to establish a prima facie case of unpatentability because Howe does not qualify as prior art under 35 USC § 102. Specifically, 35 USC § 102 states that:

A person shall be entitled to a patent unless ...
e) the invention was described in

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for the purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language;

Assignee respectfully would like to note that the present application was filed February 9, 2001 and claims priority to a provisional application filed February 15, 2000. Assignee would also like to note that Howe has a filing date of September 26, 2004. While Assignee takes no position with regard to the teaching of Howe, it is clear that Howe does not satisfy the requirements of 35 USC § 102. Specifically, Howe was not filed before the present application. Likewise, Howe is not a patent granted on an application filed before the present application. Accordingly, Assignee again respectfully requests that the Examiner withdraw this rejection.

In an earlier Advisory Action, the Examiner maintained that the rejections under Howe are proper because Howe "is a CIP of 10/412,784 filed on April 11, 2003, which is a division of now U.S. Patent No. 6,611,519, filed on August 19, 1998." The Examiner goes on to state that "Examiner rejects claim 1 on the basis of Fig. 37 of Howe reference 2005/0058149, which is also disclosed in figures 2-7 and steps 1-7 of U.S. Patent No. 6,611,519 is on August 19, 1998. Thus, the claims are given the benefit of the earlier filed application." Assignee respectfully asserts that this statement by the Examiner mischaracterizes the legal standard for determining if a document qualifies as prior art. Whether or not subject matter in Howe would have been entitled to a priority date from one of its parent applications, an issue on which Assignee respectfully does not take a position, is irrelevant for determining the date when Howe became available for prior art purposes under 35 USC § 102(e). In order to qualify as prior art under 35 USC § 102(e) a reference must be either "1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent." (emphasis supplied). The Howe reference relied upon by the Examiner simply does not satisfy this requirement because the Howe reference is not an application filed in the United States before the present application was filed. Furthermore, even if the subject matter in Howe was present in the earlier parent applications, which Assignee in no way concedes, it does not matter for determining whether or not Howe qualifies as prior art under 35 USC § 102 because determining if a reference qualifies as prior art focuses on the respective filing dates of the applications not the respective priority dates of the applications. Here, Howe was filed after the present application and therefore can not qualify as prior art because it was filed after the present application.

In addition, the Examiner is relying on Fig. 37 and paragraph 0857 of Howe. However, Fig. 37 differs from the Fig. 37 in the parent application, and the parent application does not even include 857

paragraphs. It does not appear that the specific material relied on by the Examiner was present in the parent application. In an earlier correspondence, the Examiner did, however, identify portions of US Patent 6,611,519 of Howe (hereinafter Howe II) which the Examiner asserts would support the subject matter relied on from Howe. Again, in the interest of furthering the prosecution of the present application, Assignee will attempt to respond to the Examiner's rejection as if the generally mentioned portions of Howe II formed the basis for the Examiner's improper rejections in the present application. However, Assignee respectfully requests that the Examiner point out specific paragraphs and/or drawing figures relied on from Howe II in any future Office Actions and stop relying on Howe, which, as discussed above, does not qualify as prior art with respect to the present application. In addition, if the Examiner would simply base rejections on Howe II we could focus the prosecution of the present application on distinctions between Assignee's claimed subject matter and the cited documents rather than focusing on the appropriate priority date for Howe, which as discussed above, was filed after Assignee's present application.

Moving now to the substance of the Examiner's rejections under 35 USC 103, the Examiner is reminded that to successfully make a *prima facie* rejection under 35 USC § 103, the Examiner must show that Assignee's claimed subject matter would have been obvious to one of ordinary skill in the art pertinent to Assignee's claimed subject matter at the time it was made. See *KSR International, Co. v. Teleflex, Inc.*, 127 S.Ct. 1727 (2007). Some of the factors to consider in this analysis include the differences between the applied documents and Assignee's claimed subject matter, along with the level of skill associated with one of ordinary skill in the art pertinent to Assignee's claimed subject matter at the time it was made. See USPTO Memo entitled "Supreme Court decision on KSR Int'l. Co., v. Teleflex, Inc.," (May 3, 2007). One way in which an Examiner may establish a *prima facie* case of unpatentability under 35 USC § 103 would be to show that three basic criteria have been met. First, the Examiner should show that the applied documents, alone or in combination, disclose or suggest every element of Assignee's claimed subject matter. Second, the Examiner should show that there is a

reasonable expectation of success from the proposed combination. Finally, the Examiner should show that there was some suggestion or motivation, either in the applied documents themselves or in the knowledge generally available to one of ordinary skill in the art pertinent to the claimed subject matter at the relevant time, to modify the document(s) or to combine document teachings. The motivation or suggestion to make the proposed combination and the reasonable expectation of success should be found in the prior art, and should not be based on Assignee's disclosure. See *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991); See MPEP § 2142; 2143 - § 2143.03 (regarding decisions pertinent to each of these criteria). It is respectfully asserted that the Examiner has not met these standards.

Specifically with regard to Howe II, the portions referred to by the Examiner, Figs. 2-7 and steps 1-7, in view of Piirainen do not establish a prima facie case of unpatentability under 35 USC § 103. More specifically, Howe II does not teach "interleaving one or more signals; and transmitting the interleaved one or more signals along said connection," as recited in Assignee's claim 1. The Examiner concedes as much. The Examiner, however, asserts that Piirainen cures this deficiency. However, the Examiner has failed to establish any motivation for the proposed combination either in the cited documents themselves or the knowledge of one of ordinary skill. In addition, the Examiner has not offered any rationale for the proposed combination of Howe II and Piirainen. The Examiner merely asserts that it would have been desirable to increase transmission speed. However, the Examiner does not offer any rationale for one of ordinary skill to make the proposed combination. In light of this, it is respectfully asserted that Assignee has traversed this rejection. It is therefore respectfully requested that the Examiner withdraw this rejection.

Claim 3-12 patentably distinguish from Howe II on at least a similar basis as claim 1. It is therefore respectfully requested that the Examiner withdraw these grounds for rejection as well.

With regard to the Examiner's objection to the language "capable of" in claim 6, Assignee respectfully asserts that the Examiner has not established a proper basis for this rejection. Specifically, the Examiner has not identified any statute or federal rule relating to patent claim language that is not satisfied by the language "capable of". In addition, Assignee respectfully asserts that even within the analytic framework for claim interpretation relied on by the Examiner, MPEP §2106, the Examiner has not established that "capable of" does not limit claim 6. Assignee respectfully asserts that "capable of" does not suggest or make optional the language that follows it. In the context of claim 6, "capable of", along with the language that follows, constitutes at least one limitation on claimed subject matter and the Examiner has not established any basis for his assertion to the contrary. Therefore, Assignee respectfully requests that the Examiner withdraw this objection to claim 6.

For at least the reasons above, Assignee respectfully asserts that claims 1 and 3-12 are allowable and requests that the Examiner permit these claims to proceed to issuance. Although additional arguments may exist for distinguishing the cited documents, the foregoing is believed sufficient to address the Examiner's rejections. Likewise, failure of the Assignee to respond to a position taken by the Examiner is not an indication of acceptance or acquiescence of the Examiner's position. Instead it is believed that the Examiner's positions are rendered moot by the foregoing and, therefore, it is believed not necessary to respond to every position taken by the Examiner with which Assignee does not agree.

CONCLUSION

In view of the foregoing, it is respectfully asserted that all of the claims pending in this patent application, as previously amended, are in condition for allowance. If the Examiner has any questions, he is invited to contact the undersigned at (503) 439-6500. Reconsideration of this patent application and early allowance of all the claims is respectfully requested.

Please charge any shortages and credit any overcharges of any fees required for this submission to Deposit Account number 50-3703.

Respectfully submitted,

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Steven J. Munson
Registration No. 47,812

Customer No. 43831
Berkeley Law and Technology Group, LLP
17933 NW Evergreen Pkwy., Suite 250
Beaverton, OR 97006
503-439-6500